2/21/02

**THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.**

Paper No. 25
HRW

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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William S. Quimby

v.

Lowell International Company

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Opposition No. 111,322
to application Serial No. 75/317,158
filed on June 30, 1997

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Howard N. Aronson, Robert B. Golden and Seana F.C. LaPlace of Lackenbach Siegel P.C. for William S. Quimby.

Robert D. Fish of Fish & Associates for Lowell International Company.

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Before Quinn, Wendel and Rogers, Administrative Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Lowell International Company has filed an application to register the mark 1-800-REFERRAL for "provision of information, matchmaking and concierge services via telephonic and computer assisted means."[1][1]

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[1][1] Serial No. 75/317,158, filed June 30, 1997, based on an allegation of a bona fide intention to use the mark in commerce.

William S. Quimby filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act. In the notice of opposition, opposer alleges that he has used the mark 800 REFERRAL.COM since at least May 5, 1997 for business and professional locator and information services; that he is the owner of a pending application, Serial No. 75/301,752 for the mark for use in connection with these business and professional locator and information services; that since the services identified in applicant's application are closely related to the services provided by opposer under his 800 REFERRAL.COM mark, and since applicant's mark 1-800-REFERRAL is virtually identical to opposer's mark, contemporaneous use of the respective marks for the services will create a likelihood of confusion; and that opposer has superior rights in that opposer has been using his mark in commerce continuously and prior to any date claimed or available to applicant.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The Record

The record consists of the file of the involved application; opposer's trial testimony depositions, with accompanying exhibits, of Conrad J. Lowell, president of applicant and William S. Quimby; applicant's responses to certain of opposer's discovery requests, made of record by opposer's notice of reliance; and applicant's trial testimony deposition, with accompanying exhibits, of Conrad J.

Lowell.[2][2] Both opposer and applicant have filed briefs but an oral hearing was not requested.

The Priority Issue

During the taking of the testimony deposition of William Quimby, the parties entered into the following stipulation:

> William Quimby d/b/a/ Toll Free Referrals first used the following marks, 1-800 4 REFERRAL word mark and 800 4 REFERRAL.com logo mark, as shown on Exhibit 17, in interstate commerce in the U.S. in May 1997 and has used these marks continuously in commerce in the U.S. since May 1997, and that such use of such marks would be sufficient to establish trademark rights for the purpose of this opposition but for any prior rights of applicant in the 1-800 REFERRAL mark which may exist.[3][3]

In its brief, applicant acknowledges that there is a likelihood of confusion if opposer's marks and applicant's 1-800-REFERRAL mark are used contemporaneously in connection with the business and professional locator services of the parties. We agree that there would be a

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[2][2] Opposer's objections with respect to the evidence submitted by applicant to support use of its mark in 1989 and 1997 have been taken into consideration in determining the probative weight to be given to the evidence. The objection to applicant's evidence of use since the beginning of this proceeding, Exhibits 501-527, as being irrelevant is well taken and no weight has been given to this evidence.

[3][3] Opposer uses several variations of the 800 REFERRAL.COM mark pleaded in the notice of opposition, including those being relied upon in this stipulation. Although opposer failed to amend the notice of opposition to rely upon all these variations, in view of the stipulation, we consider the pleadings so amended to conform with the issues tried by the express consent of the parties. See FRCP 15(b).

likelihood of confusion. Thus, the only issue remaining for our consideration is whether applicant can establish use of its mark prior to the May 1997 date of opposer.

Applicant's involved application was filed on the basis of an allegation of a bona fide intention to use the mark in commerce.[4] Accordingly, applicant's constructive use date is that of the filing date of the application, namely, June 30, 1997. It has long been settled that in a use-based application, an applicant is not bound by the date of first use alleged in an application, but rather may carry the date of first use back to a prior date by proper evidence. Such an applicant is under a heavy burden and his proof of an earlier date must be clear and convincing and must not be characterized by contradictions, inconsistencies, and indefiniteness. See George Putnam & Co., Inc. v. Hydro-Dynamics Inc., 228 USPQ 951 (TTAB 1986), aff'd , 811 F.2d 1470, 1 USPQ 1772 (Fed. Cir. 1987). The same holds true for an applicant filing an intent-to-use application; the applicant may prove a date of use prior to the constructive use date afforded by the filing date of the application. See Dyneer Corp. v. Automotive Products plc, 37 USPQ2d 1251 (TTAB 1995). The burden of proof necessarily remains the same, that of clear and convincing evidence. Applicant has specifically agreed that the applicable standard here is just that, clear and convincing proof of an earlier date of use.

To establish ownership of or, in other words, rights in a mark, the prior user must establish not only that at some date in the past it used the mark, but that such use has continued to the present. Such a continuous use implies something more than mere sporadic use or de minimis sales. 2 J. T. McCarthy, McCarthy on Trademarks and Unfair Competition, § 16:9 (4th ed. 2001).

The oral testimony of a single witness may suffice in proving priority, if sufficiently probative. To be determinative, the testimony must not be characterized by contradictions, inconsistencies and indefiniteness, but rather must carry a conviction of accuracy and applicability. B. R. Baker Co. v. Lebow Bros., 150 F.2d 580, 66 USPQ 232 (CCPA 1945). Oral testimony is obviously strengthened by documentary evidence which corroborates the dates of use. Elder Manufacturing Co. v. International Shoe Co., 194 F.2d 114, 92 USPQ 330 (CCPA 1952). Mr. Lowell, in his testimony, stated that applicant began its referral business in 1987 or 1988. The only documentary evidence of the promotion of such service at about that time consists of two solicitation letters which applicant sent in July 1989 to the Dental Society of New York and the Florida Bar seeking participation by their members in a referral service of patients or clients to them by means of the toll free 1-800-REFERRAL number. The 1-800-REFERRAL mark was used in connection with these proposals. These solicitations did not result in any agreement to

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[4][4] The evidence shows that applicant had filed two earlier intent-to-use applications for the same mark, both of which were

participate. To the contrary, some question was raised as to the ethical considerations of such referrals, and no services were provided or revenues received as a result of these proposals. The only remaining documentary evidence consists of an advertisement placed in the Chicago Tribune for a travel agency referral in July 1997, a date later than opposer's stipulated date of first use and far removed from applicant's earlier claimed use.

Thus, we must rely solely upon applicant's oral testimony of continuing use of its mark from 1987, or later in the 1980s, until 1997. Mr. Lowell testified that his target market when he originated the idea of applicant's referral business in the "beginning of '90s" or "end of '80s" was dentists, doctors and lawyers, but this attempt was not successful. His next tack was to use the mark in the early 1990s in connection with advertising on fliers for a 3-D camera. In some areas applicant was selling the camera itself. In other areas in New York and New Jersey, applicant was referring customers to other sellers for a fee. This also was unsuccessful; and the next step was the travel agency advertisement in 1997, a third unsuccessful venture.

Applicant has admitted that there were periods during the 1990s when, for more than a year, the mark was not

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abandoned.

actively being used. In these periods applicant was "rethinking" and attempting to come up with new strategies of use for a referral service. In addition, applicant testified that 1-800-REFERRAL is and has been used as a toll-free telephone number which is passed along to clients of applicant's other business, namely the sale of food products and magazines.

As to the amount of use of the 1-800-REFERRAL mark for the referral services identified in the application over the ten year period, Mr. Lowell's testimony is inconsistent, contradictory and vague. At one point, he testified to total uses of the 1-800-REFERRAL mark numbering in the hundreds or thousands. At other points, he discusses only ten or more referrals to lawyers and the receipt of around 100 calls for referrals in general. Applicant's interrogatory response as to use before May 1997 is limited to ten examples, although Mr. Lowell explains this as being the only ones for which written evidence existed. Such evidence was not in its entirety part of the record before us.

While acknowledging that applicant has never reached any written agreement with any individual or entity to whom or to which applicant made any referral, and has never received any revenue for referral services, Mr. Lowell

claims to have made oral agreements with individual lawyers for trial runs of the service, perhaps 50 to 100 over a period of ten years. Similar arrangements were purportedly made with dentists, although there was never any payment made because an insufficient number of patients were referred. Mr. Lowell in fact testified that much of applicant's advertisement and solicitation was by verbal means over the telephone.

There is no testimony as to the means by which the availability of the referral service was made known to the general public under the 1-800-REFERRAL mark, other than the single advertisement in the Chicago Tribune in July 1997 and earlier references to the mark as an information telephone number being given out by Lowell's employees in connection with applicant's other business. While Mr. Lowell refers to telephone inquiries he has received over a period of years, he provides no information as to how these callers were made aware of applicant's services being offered in connection with this telephone number. At times the referrals given out in response to these telephone calls were obtained by Mr. Lowell from the Yellow Pages of the appropriate telephone book, rather than as the result of even a transitory agreement with a professional seeking referral clients.

Applicant has clearly failed to carry its burden of proving by clear and convincing evidence, not only a first use date prior to the May 1997 first use date of opposer but also of continuous use in commerce since any such first use. Even if we accept the solicitation letters sent by applicant to the New York Dental Association and the Florida Bar in 1989 as evidence of an initial offering of applicant's professional locator services, we find often conflicting, and at best sporadic, evidence as to the actual rendering of referral services in connection with the 1-800-REFERRAL mark. The number of referrals to lawyers or dentists from 1989 to May 1997 is minimal. Evidence with respect to the means by which callers became aware of applicant's services or of applicant's use of its mark in the promotion or rendering of these services is non-existent. The use by applicant of 1-800-REFERRAL as a toll-free number for its food products and magazine business is not a use of the term as a mark in connection with the specific referral services of the involved application. Similarly, the use of 1-800-REFERRAL on fliers advertising 3-D cameras being sold by applicant cannot be relied upon as use of the mark in connection with the referral services. Instead these uses must be construed as uses ancillary to the other businesses of applicant. See In re Betz Paperchem, Inc., 222 USPQ 89 (TTAB 1984).

Accordingly, we find that applicant has failed to establish by clear and convincing evidence that it has made continuous commercial utilization of the mark 1-800-REFERRAL from a time late in the 1980s until May 1997. Applicant has failed to establish rights in its mark prior to the date of first use of May 1997

which opposer has been accorded by stipulation of the parties. Opposer has priority of use for its marks.[5][5] The likelihood of confusion has been admitted by applicant.

Decision: The opposition is sustained and registration is refused to applicant.

[5][5] In view of decision on the issue of priority, we find no need to consider the issue of abandonment which has also been raised by opposer.